REMARKS

This paper is filed in response to the Examiner's Action mailed 01 December 2003.

The application was initially filed on 04 October 2000 with twenty-four claims. Upon the examination, in an Office Action mailed 01 December 2003, the Examiner rejected claims 1, 9, and 17 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent 6,108,709 entitled SYSTEM FOR SENDING AN E-MAIL MESSAGE TO A FIRST TYPE OF TERMINA BASED UPON CONTENT THEREOF AND SELECTED CONDITIONS AND SELECTIVELY FORWARDING IT TO A SECOND TYPE OF TERMINAL to Shinomura et al. (Shinomura '709). The Examiner further rejected claims 3-4, 11-12 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Shinomura '709 in view of U.S. Patent 6,438,583 B1 entitled SYSTEM AND METHOD FOR RE-ROUTING OF E-MAIL MESSAGES to McDowell et al. (McDowell '583). The Examiner further rejected claims 5-8, 13-16 and 21-24 under 35 U.S.C. §103(a) as being unpatentable over Shinomura '709 in view of U.S. Patent 6,163,809 entitled SYSTEM AND METHOD FOR PRESERVING DELIVERY STATUS NOTIFICATION WHEN MOVING FROM A NATIVE NETWORK TO A FOREIGN NETWORK to Buckley (Buckley '809).

Applicant has amended the claims. Claims 1-24 are pending.

The Rejection of claims 1, 2, 9, 10, 17 and 18 under 35 U.S.C. §§102(a) and 103(a)

The Examiner first rejected claims 1, 9, and 17 under 35 U.S.C. §102(a) as being anticipated by Shinomura '709. The Examiner asserts that Shinomura '709 teaches a system having an alternate forwarding function for sending the message to an alternate receiver when communication is not established under a predetermined condition. In response, Applicant has amended the claims to more distinctly point out and claim that the subject matter of the invention is an extended parameter in the SMTP mail protocol that facilitates naming alternate recipients of an email address and provides for delivery of the message to the alternate recipients.

Shinomura '709 teaches a method and the interface for a user of a graphical user interface of an email application, such as Lotus Notes, Eudora, Outlook Express, to

enter several alternative addresses whereby the alternative addresses are different receiving terminals, such as a PHS service device or a pager device or a cellular phone, etc. After a time-out period, if the email has not been delivered to the original email address, the sender then forwards the message to another email address at a different receiving terminal and so on.

Simply, the Examiner is requested to remove the rejection of claims 1, 9, and 17 under 35 U.S.C. §102(a) because *Shinomura '709 does not teach the claimed extended parameter/keywords in the SMTP protocol.*

The Examiner, however, also rejects claims 2, 10, and 18 under 35 U.S.C. §103(a) as being obvious in view of Shinomura '709. Applicant respectfully traverses this rejection and any presumption that claims 1, 9, and 17 may also be obvious under the same art using the same argument. The Examiner admits that Shinomura '709 does not explicitly teach the addition of ARCPT (Alternate Recipient) parameter in the SMTP protocol but states that one of ordinary skill in the art could modify the teachings of Shinomura '709 because it would allow the system to expand the SMTP extensions to automatic forward the message to the alternate recipients/receivers in case of inability to deliver to the original.

Applicant traverses because Shinomura '709 is based on an email application installed on a client from which a user sends an email. The extensions of the SMTP protocol provided by Applicant's claimed invention is independent of the email application used by the sender. Another difference is that Shinomura '709 does not resend to an alternative different receiving terminal unless and until a predetermined condition exists and the only condition presented by Shinomura '709 is a predetermined period of time, i.e., if the email was not received by a first email address within a predetermined period of time, the sender's client resend the message to a different address in its address book. Thus, a major difference that cannot be overcome by obviousness is that Shinomura '709 requires the sender's client to resend the message each time, i.e., Shinomura '709 is an application program interface such that if an original message has not been delivered within a time-out period programmed into the sender's client, then the email application will read an alternative email address in its

address book and send the message to a different email address in a different receiving terminal and, if necessary, will truncate the email to accommodate the different receiving terminal. The second and third alternative messages still originate at the sender's client. Because Applicant's invention is claimed as an extension to the SMTP protocol, the message, if undeliverable to the original recipient, need not be resent from the sender's client; rather the message is seamlessly forwarded to the email address specified by the SMTP extension by any server downstream from the sender's client.

Yet, additional differences are that Shinomura '709 works at the email application level whereas Applicant's invention works at the mail protocol layer. Note that Shinomura '709 was aware of email protocols, *see* Shonomura '709 at column 9, lines 45-54, and Shinomura '709, most probably, was aware that the SMTP protocol has been used for over a decade. Yet even with this presumed knowledge, Shinomura '709 does NOT suggest nor teach any method whereby those addresses for different receiving terminals can be inserted into the SMTP mail protocol. The Examiner is not free to using hindsight and Applicant's teachings to suggest a modification or combination where none has been suggested and does not exist. Respectfully, because Shinomura '709 does not suggest that the email addresses of the different receiving terminals can be inserted into the mail protocol layer, Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-2, 9-10, 17-18 under 35 U.S.C. §103(a).

The Rejection of claims 3-4, 11-12 and 19-20 under 35 U.S.C.§103(a)

The Examiner further rejects claims 3, 4, 11, 12, 19 and 20 under 35 U.S.C.§103(a) under the alleged combination of Shinomura '709 and McDowell '583. Again, the Examiner admits that Shinomura '709 does not teach an extension to the SMTP server to include automatic forward of the message to the alternate recipients. The Examiner then relies on McDowell '583 for rerouting an email sent to a prior address to a new address of an intended recipient through the SMTP implementation.

Recall that Shinomura '709 teaches that upon a time-out, the email application installed on the client will look up the next email address in the address book and then resend the message to the next address and, if necessary, truncate the message. McDowell '583 teaches a re-routing server facility and service whereas when a user abandons a first email address, she/he may register with a re-route server and have email forwarded to the re-route server and then to a different email address.

Applicant asserts that one of ordinary skill in the art would not look to McDowell '583 to address the shortcomings of Shinomura '709; and second the alleged combination is still not Applicant's claimed invention. Shinomura '709 teaches automatic resending email from the first client to a different receiving terminal when a determined period of time has been realized. McDowell '583 simply forwards email to a re-router server and then to an email address if the first older or abandoned email address associated with an Internet Service Provider (ISP) is no longer in use. McDowell '583 provides several embodiments for forwarding mail from an old Internet Service Provider (ISP) address to a re-router server and then to a new ISP, such as a .forward file embodiment, an email alias embodiment, a LDAP embodiment, etc. Even so, McDowell '583 was aware of the SMTP protocol, *see* column 5, lines 3-16 and column 6, lines 20-29. *Yet, neither McDowell '583 nor Shinomura '709 suggest an extension to the SMTP protocol, as claimed by Applicant.* The Examiner is not free to suggest a combination or a modification when the references themselves do not suggest their combination or modification. Because neither McDowell '583 nor Shinomura '709 suggest an extension to the SMTP protocol; McDowell '583 forwards email at a hardware level and Shinomura '709 resends email at a software level from the original server regardless of mail protocol. Applicants respectfully request the Examiner to withdraw the rejection of claims 3, 4, 11, 12, 19, and 20 under 35 U.S.C.§103(a).

The Rejection of claims 5-8, 13-16 and 21-24 under 35 U.S.C.§103(a)

The Examiner rejects claims 5-8, 13-16 and 21-24 under 35 U.S.C.§103(a) employing a combination of Shinomura '709 and Buckley '809. As above, the Examiner admits that Shinomura '709 does not teach notification to the user of an email system of successful delivery to alternate recipients. The Examiner, however, asserts that Buckley '809 teaches the preservation of delivery status notification (DSN) and some additional DSN options.

Shinomura '709 is discussed as above and teaches a way for a user to enter email addresses of different receiving terminals for the same recipient into an email address program, and then through a modification of the email application program interface, if delivery was not successful within a period of time, the email would be resent from the originator to a different email address in the address book. Buckley '809 provides for preserving original delivery status notification information and translating the delivery status notification information into the closest option supported by the receiving network. Buckley '809 provides the example of translating delivery status notifications from an SMTP network to an X.400 network, *see* column 3, lines 22-47.

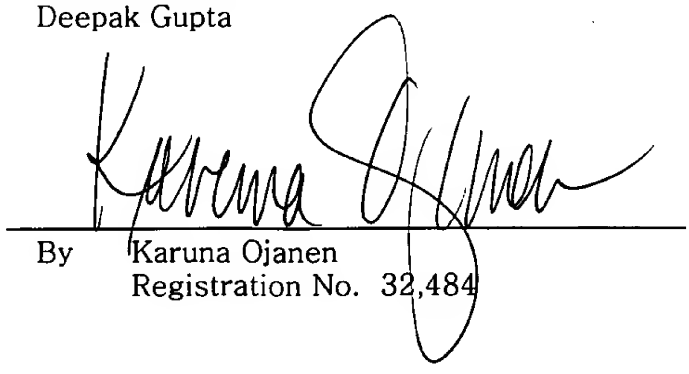
Indeed, Buckley '809 could be combined with Shinomura '709 but the combination would still not yield Applicant's claimed invention because *Shinomura '709 still does NOT teach an extension to the SMTP protocol as noted above and Buckley '809 also does NOT teach the claimed ARCPT extension of the SMTP protocol, nor the ALTERNATE delivery status notification.* Buckley '809 would merely translate the novel and nonobvious extensions and keywords of the SMTP protocol claimed by the Applicant into another network protocol which could possibly be used by one of the different receiving terminals as described by Shinomura '709. Thus, Applicant respectfully requests the Examiner to withdraw the rejection of claims 5-8, 13-16 and 21-24 under 35 U.S.C.§103(a).

CONCLUSION

In summary, Applicant has amended the claims to distinctly point out and claim two extensions to the SMTP mail protocol, the ARCPT extension and the ALTERNATE keyword. *Shinomura '709 does not teach alternative SMTP extensions* but merely teaches a device and a method by which an email can be resent to different addresses within a different receiving terminals. *McDowell '583 does not teach alternative SMTP extensions* but teaches a way by which a first ISP can forward email to a re-router server who then routes the email to a second ISP. *Buckley '809 does not teach alternative SMTP extensions* but instead tells us how to translate all these extensions, delivery status notifications, etc. among the different email protocols and networks. If none of the references suggest or teach these SMTP extensions, how can their combination possibly teach or suggest the claimed invention? In contrast. Applicant's claimed invention is quite compelling in its simplicity and coordination with the SMTP protocol when contrasted with different receiving terminals, different and abandoned ISPs, and different networks of the referenced patents. Thus, Applicant respectfully requests the Examiner to review the amendments and the remarks and to pass the application to issuance. The Examiner is further invited to telephone the Attorney listed below if he thinks it would expedite the prosecution and the issuance of the patent.

Date: 01 March 2004

Respectfully submitted,
Deepak Gupta



By Karuna Ojanen
Registration No. 32,484

Voice Telephone: 507.285.9003
Fax: 507.525.5345